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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,912	01/29/2002	Yutaka Iyoki	P21952	3713
7055	7590	03/14/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			PATEL, CHIRAG R	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/057,912	IYOKI, YUTAKA	
	Examiner	Art Unit	
	Chirag R. Patel	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 2001-026646.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

The information disclosure statement filed January 5, 2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because patent application numbers "2001/014908" and "2002/133573" was unable to be identified by the patent application publication number. The correct format for the patent application number is a 11 digit number and the ones listed above and in the IDS are 10 digits.

It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Objections

Claim 1 is objected to because of the following informalities: The preamble fails to include the statement "wherein the improvement comprises" or "comprising" or "comprising of". Appropriate correction is required.

Claim 1 is objected to because of the following informalities: The preamble states "An IP address stored in memory in a scanner apparatus is assigned from said

Art Unit: 2141

scanner apparatus". There is no mention of the scanner apparatus assigning an IP address in the disclosure. Appropriate correction is required.

Claim 5 is objected to because of the following informalities: "scanns" is misspelled. Appropriate correction is required.

Claims 14, 15, and 16 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 14 and 15 mentions "The apparatus according to claim 13" and Claim 16 discloses "The system according to claim 13". Claim 14, 15 and 16 disclose different subject matter which is apparatus and system, and fails to limit the subject matter of the "user terminal information registering method"

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claims 3, 6-12 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3, 7, 11 and 15: It is unclear as to the meaning of the recitation of "belonging information". The examiner interprets "belonging information" as authorized clients/users that have permissions to use the network scanner.

Claims 6-8, and 10-12, 14-15 recites the limitation "the apparatus" in line 1. There is insufficient antecedent basis for this limitation in these claims.

Claim 9 provides for the use of user terminal apparatus that receives image information and stores it to into an information storing section, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35

Art Unit: 2141

U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 16 recites the limitation "the system in claim 13" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 4-5, 8-9, 12-13 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Kumpf et al. (US 6,223,223).

As per claim 1, Kumpf et al. discloses an an image information transmitting system that directly transmits image information to a user terminal apparatus (Col 6 lines 1-7)

to which an IP address stored in memory in a scanner apparatus is assigned from said scanner apparatus via a network, (Col 2 lines 36,42, 61-66, Col 4 lines 12-14, Col 5 lines 41-43) The TCP/IP network supports IP addresses. (Col 2 lines 64-65)

Art Unit: 2141

wherein said user terminal apparatus broadcasts a search signal on said network
(Col 2 lines 61-63)

scanner apparatus sends back a response signal including an IP address of said scanner apparatus to said user terminal apparatus when monitoring said search signal so as to receive said search signal, (Col 3 lines 15-20) The TCP/IP network supports IP addresses. (Col 2 lines 64-65)

said user terminal apparatus transmits user terminal information including an IP address of at least said user terminal apparatus to the IP address of said scanner apparatus to said scanner apparatus when receiving said response signal (Col 3 lines 15-20) The TCP/IP network supports IP addresses. (Col 2 lines 64-65)

and said scanner apparatus receives said user terminal information and stores said received user terminal information to said memory. (Col 4 lines 12-14, Col 5 lines 41-43)

As per claim 5, Kumpf et al. discloses a scanner apparatus comprising:
a scanner section which scans a document to obtain image information;(Col 5 lines 64-68, Col 6 line 1)
memory which stores an IP address assigned to one or two or more user terminal apparatuses connected to a network; (Col 2 lines 36,42, 61-66, Col 4 lines 12-14, Col 5 lines 41-43) The TCP/IP network supports IP addresses. (Col 2 lines 64-65)

Art Unit: 2141

and an image information transmitting section which directly transmits said image information to said user terminal apparatus to which the IP address called up from said memory by a user is assigned, (Col 6 lines 1-7)

wherein said scanner apparatus ; The server supports being a part of an internal central processing unit (CPIJ) of the peripheral, which is a scanner. (Col 2 lines 60-61, Col 2 lines 65-66, Col 3 line 2-4, Figure 1 items 10,16)

monitors a search signal broadcasted on said network from said user terminal apparatus, (Col 2 lines 61-63)

sends back a response signal including an IP address of said scanner apparatus to said user terminal apparatus when receiving said search signal, (Col 3 lines 9-10, Col 3 lines 18-19, Col 2 lines 64-65)

and receives user terminal information including an IP address of at least said user terminal apparatus transmitted to the IP address of said scanner apparatus from said user terminal apparatus and stores said received user terminal information to said memory. (Col 2 lines 36,42, 61-66, Col 4 lines 12-14, Col 5 lines 41-43) The TCP/IP network supports IP addresses. (Col 2 lines 64-65)

As per claim 9, Kumpf et al. discloses a user terminal apparatus comprising: an image information receiving section which receives image information transmitted from one or two or more scanner apparatuses connected via a network; (Col 6 lines 7-9)

Art Unit: 2141

and an image information storing section which stores said image information, (Col 6 lines 11-12)

wherein when said user terminal apparatus broadcasts a search signal on said network (Col 2 lines 60-63)

and receives a response signal including an IP address of said scanner apparatus sent back by said scanner apparatus that has received said search signal, (Col 3 lines 16-20) The TCP/IP network supports IP addresses. (Col 2 lines 64-65)

said user terminal apparatus transmits user terminal information including an IP address of at least said user terminal apparatus to the IP address of said scanner apparatus to said scanner apparatus. (Col 3 lines 16-20, Col 4 lines 12-14) The TCP/IP network supports IP addresses. (Col 2 lines 64-65)

As per claim 13, Kumpf et al. discloses a user terminal information registering method comprising:

broadcasting a search signal on a network from a user terminal apparatus; (Col 2 lines 61-65) sending back a response signal including an IP address of a scanner apparatus to said user terminal apparatus when said scanner apparatus monitors said search signal and receives said search signal; (Col 3 lines 16-20) The TCP/IP network supports IP addresses. (Col 2 lines 64-65)

transmitting user terminal information including an IP address of at least said user terminal apparatus to the IP address of said scanner apparatus to said scanner

Art Unit: 2141

apparatus when said user terminal apparatus receives said response signal; (Col 3 lines 16-20) The TCP/IP network supports IP addresses. (Col 2 lines 64-65)

and receiving said user terminal information by said scanner apparatus so as to store said received user terminal information to memory. (Col 2 lines 36,42, 61-66, Col 4 lines 12-14, Col 5 lines 41-43)

As per claims 4, 8, 12, and 16, Kumpf et al. discloses wherein said user terminal information includes a user name other than the IP address of said user terminal apparatus, and said scanner apparatus stores said IP address and said user name to said memory to be associated with each other, and when the user inputs said user name, said scanner apparatus calls up the IP address associated with said input user name from said memory. (Col 2 lines 36,42, 61-66, Col 3 lines 46-57, Col 4 lines 12-14, Col 5 lines 41-43, Col 6 lines 1-2)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 6, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumpf et al. (US 6,223,223) in view of Davis et al. (6,167,462).

Art Unit: 2141

Kumpf et. al discloses wherein said user terminal information includes the IP address of said user terminal apparatus, said scanner apparatus stores said IP address to said memory to be associated with each other, (Col 2 lines 36,42, 61-66, Col 4 lines 12-14, Col 5 lines 41-43) The TCP/IP network supports IP addresses. (Col 2 lines 64-65) and a user calls up said IP address to instruct transmission of image information, said scanner apparatus transmits said image information to said user terminal apparatus (Col 5 line 67, Col 6 lines 1-5) Kumpf et. al fails to teach the password protection feature of this invention.

Davis et al. discloses wherein said user terminal information includes a password other than the IP address of said user terminal apparatus and when a password entered according to a request for inputting a password matches said password associated with said IP address and scanner apparatus transmits said image information to said user terminal apparatus when a password entered according to a request for inputting a password matches said password associated with said IP address. (Col 3 lines 1-11, Figure 4 item 306). It would have been obvious to a person of ordinary skill in the art at the time of invention to add a password protection feature in the disclosure of Kumpf et al. because once a scanner is selected, it is reserved to the computer system, so that no other computer system can access the scanner. (Col 1 lines 34-36)

Claims 3,7,11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumpf et al. (US 6,223,223) in view of UHLER et al.

Art Unit: 2141

(US2001/0039587) Kumpf et al. discloses a broadcasted search signal of the user terminal apparatus (Col 2 lines 61-63) and the response signal of the scanner apparatus, (Col 3 lines 15-20). Kumpf et al. fails to disclose "belonging information". UHLER et al. discloses whether the request is from an authorized client who has the ability to use the network scanner. ([0068], Figure 3: item 308) It would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate "*belonging information*" into the disclosure of Kumpf et al. because it allows for checking whether the network scanner is requested by an authorized client. [0068]

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kumpf et al. (US 6,839,755) discloses a method for network peripheral discovery. Yokomizo et al. (US 6,321,266) discloses an input/output apparatus that processes a first data format into a second data format for an information terminal device. Lo et al. (US 5,911,044) discloses a scanning system which transfers an image from a scanner over a network to a client computer. Goshey et al. (US 6,327,613) discloses a system for transparently sharing peripheral devices over a network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag R. Patel whose telephone number is (571)272-

Art Unit: 2141

7966. The examiner can normally be reached on Monday to Friday from 7:30AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RUPAL DHARIA
SUPERVISORY PATENT EXAMINER